

REMARKS

Claims 58-81 are pending in this application.

Claims 58, 69 and 80 are independent.

Claims 69, 72, 74, and 81 have been amended, in a non-narrowing manner, to correct minor editorial errors, not for purposes of patentability. No new matter is added.

It should be noted that in the most recent Official Action, paper no. 14, the Examiner refers to the prior response, dated May 23, 2003, as an "amendment". The paper of May 23, 2003 is a Request for Reconsideration, not an Amendment.

Claim 81 now stands rejected under 35 U.S.C. §112, second paragraph, as being indefinite. Claims 58, 63, 65-69, and 74-79 now stand rejected under 35 U.S.C. §102(e) as anticipated by Van Dusen (U.S. Patent No. 6,175,823). Claims 58, 65, 67-69, 75, 76, 79 and 80 now stand rejected under 35 U.S.C. §103(a) as obvious over Van Dusen in view of the Lenhart publication (Lenhart, J. "'Happy Holidays,' High-Tech Style; Sending Cards Over the Internet Gains Popularity," the Washington Post (December 20, 1998)). Claims 59-62, 64 and 70-73 now stand rejected under 35 U.S.C. §103(a) as obvious over Van Dusen in view of Albrecht (U.S. Patent No. 5,984,180). Claims 59-62, 64, and 70-73 stand rejected under 35 U.S.C. §103(a) as obvious over the Van Dusen/Lenhart combination in further view of Albrecht. Claims 66, 77, 78, and 81 stand rejected under 35 U.S.C. §103(a) as obvious over the Van Dusen/Lenhart combination in further view an Official Notice. The rejections are respectfully traversed.

The arguments previously presented in traversal of prior rejections based on the prior art applied in the Official Action to which this response relates are hereby reasserted in their entirety herein by reference.

Indefiniteness Rejection of Claim 81

The Examiner argues that it is unclear to which of the service provider deposit account or the donor deposit account the recited "deposit account" of the final limitation of claim 81 refers. It is respectfully submitted that claim 81 is unambiguous. The plain language of the claim requires that the funds that are directed to be credited (as recited in claim 58) be credited from the deposit account associated with the service provider. Accordingly, no amendment of claim 81 is necessary. It is respectfully requested that the Examiner reconsider and withdraw the 35 U.S.C. §112, second paragraph, rejection of claim 81.

Anticipation Rejection of claims 58, 63, 65-69, and 74-79 by Van Dusen

Independent claim 58, from which claims 63 and 65-68 depend, requires, *inter alia*, that (1) a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, be received via a network; (2) the received request be processed to generate the electronic greeting card including a notification of the monetary gift; (3) the generated electronic greeting card be transmitted, via the network, to the designated recipient, and (4) a credit of funds equal to the amount of the monetary gift to a deposit account be directed.

Independent claim 69, from which claims 74-79 depend, requires, *inter alia*, (1) a communications port configured to receive a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, via a network, and (2) a processor configured to process the received request to generate the electronic greeting card

including a notification of the monetary gift, and to direct a crediting of a deposit account in the amount of the monetary gift.

In the most recent Official Action, responding to prior traversal arguments that Van Dusen does not teach electronic greeting cards, the Examiner again argues that Van Dusen teaches such. In particular, the Examiner relies upon the optional message of Van Dusen, such as "Happy Birthday Mom!!", shown in both Figures 1 and 2, in making his argument. As best understood, it is the Examiner's position that inclusion of optional text that could be included in an electronic greeting card makes the e-mail message of Van Dusen an electronic greeting card.

As previously discussed, the phrase "electronic greeting card(s)", also known as "e-card(s)" is well understood in the art. Exemplary electronic greeting cards are currently available at numerous Web sites, many of which have been in operation now for many years. The TechEncyclopedia, hosted by TechWeb at techweb.com/encyclopedia/defineterm?term=e-card, defines an electronic greeting card as follows: "in addition to your own text, e-cards allow different backgrounds, images and music to be used." A similar description of electronic greeting cards is found in the Lenhart reference. An electronic greeting card is the electronic equivalent to a paper greeting card.

Van Dusen, as previously argued, does not disclose, or even suggest, electronic greeting cards. Rather, Van Dusen discloses an e-mail message sent to a recipient that communicates the giving of a gift certificate. As is commonly understood, an e-mail message is an electronic equivalent of a paper letter. The Examiner's attention is courteously directed to Figure 2, which shows the message as delivered to the recipient. Text included in Figure 2 clearly and unambiguously identifies the message as an e-mail message: "DON'T DELETE THIS MESSAGE! You'll need this **email** or the claim code below to redeem your gift certificate."

(emphasis added) Also, the Examiner's attention is courteously directed to Figure 5, detail 94, that teaches "create email document with instructions for manual redemption".

Furthermore, the Detailed Description of Van Dusen exclusively refers to the message as an e-mail message. For example, at column 3, lines 64-65, Van Dusen recites "Fig. 2. Illustrates the general form of the gift certificate e-mail document ("e-mail") that is sent to the recipient." Also, at column 4, lines 24-25, Van Dusen recites "...the e-mail also preferably includes...". Still further, at column 6, lines 35-36, Van Dusen recites "[t]he application 72 also generates an e-mail document to send to the recipient."

The mere fact that an e-mail message contains similar text to that which might be contained in an electronic greeting card does not somehow transform the e-mail message into an electronic greeting card, just as the mere fact that a letter contains similar text to that which might be contained in a paper greeting card does not somehow transform the letter into a paper greeting card. As pointed out in prior traversal arguments, Van Dusen lacks any teaching or suggestion whatsoever regarding greeting cards, electronic or otherwise.

Discussed above, independent claims 58 and 69 each require, *inter alia*, a **monetary gift** amount and directing a crediting of funds equal to the monetary gift amount to a **deposit account**. The monetary gift of the present invention is equivalent to a cash gift. That is, the recipient of the monetary gift can do with the monetary gift whatever he or she likes. There is no limitation whatsoever placed on the monetary gift. The monetary gift may be utilized however the recipient chooses, not subject to any terms and conditions. The recipient might choose to pay a bill with the monetary gift, the recipient might choose to invest the monetary gift, the recipient might choose to make a purchase with the monetary gift, or the recipient may

choose to donate the monetary gift, among different ways the monetary gift might be utilized by the recipient. Furthermore, no redemption process is necessary to enjoy the benefits of a monetary gift.

A deposit account, as will be understood by one of ordinary skill in the art, is an account such as a checking account or savings account maintained at a financial institution, such as a bank or credit union. A deposit account is not a credit account. That is, a deposit account holds funds belonging to a depositor. The depositor can do with the held funds as he or she sees fit.

The Examiner continues to rely upon Van Dusen's disclosure of a gift certificate in rejecting the present claims, equating such with a monetary gift. A gift certificate is simply not, as will be understood by one of ordinary skill in the art, a monetary gift. That is, the recipient of a gift certificate must redeem the gift certificate in accordance with certain terms and conditions, typically including the gift certificate only being valid, i.e., redeemable, with a certain merchant, or merchants, for a certain period of time. The Examiner even recognizes this fact (see, for example, paper no. 14, page 20, lines 1-3).

According to Van Dusen, the electronic gift certificate must be redeemed, and must be redeemed through the entity that issued the electronic gift certificate. As disclosed in column 4, lines 24-32, a recipient must redeem the gift certificate by purchasing items from the entity having issued the gift certificate. Furthermore, the gift certificate of Van Dusen expires after a certain period of time. (See, for example, the paragraph bridging columns 5 and 6.) Thus, the gift certificate of Van Dusen is not a monetary gift.

The Examiner points to the Abstract, column 2, lines 58-64, column 3, lines 37-67, column 4, lines 33-54, and column 5, lines 1-10 of Van Dusen as disclosing directing a crediting of funds equal to a monetary gift amount to a deposit account. It

is acknowledged that Van Dusen discloses an account, however it is respectfully submitted that Van Dusen does not disclose a deposit account. Rather, the Examiner-referenced text of Van Dusen discloses crediting an amount of a gift certificate (not a crediting of funds) to a merchant account (e.g. Amazon.com). The merchant account of Van Dusen does not hold funds for the recipient. Rather, the merchant account of Van Dusen includes an indication that a gift certificate amount may be deducted from one or more future purchases made from that merchant. Thus, the merchant account of Van Dusen is not a deposit account.

In summary, Van Dusen does not teach or suggest, as required by each of independent claims 58 and 69:

- an electronic greeting card
- a monetary gift; and
- directing a crediting of a deposit account

So, it is entirely unclear how what is disclosed in Van Dusen could possibly anticipate independent claim 58, and each of its dependencies, claims 59-68 and 81, and independent claim 69, and each of its dependencies, claims 70-79.

Dependent claims 63 and 74 require, *inter alia*, the further transmission, to a non-designated recipient, of the electronic greeting card, including a hyper-link and the notification of the monetary gift, which had been transmitted to the designated recipient. In the most recent Official Action the Examiner acknowledges that the previously applied prior art combination (the Van Dusen/Lenhart combination in further view of WishClick) does not disclose the limitations of claims 63 and 74 and withdraws the rejection. The Examiner, as can best be understood, now rejects these claims as being anticipated by the Van Dusen reference alone. However, the Examiner never addresses claims 63 and 74 in the detailed rejection. The Examiner

provides no rational basis for the rejection. Hence, the Examiner has failed to establish a prima facie case of anticipation regarding claims 63 and 74.

Claims 65 and 76 each require, *inter alia*, that the received request to send an electronic greeting card and to make an associated monetary gift in an amount, be processed to determine if the designated recipient is a member of an enclosed community prior to processing the request to generate the electronic greeting card including the notification of the monetary gift. Since Van Dusen lacks an electronic greeting card, a monetary gift, and a deposit account, it necessarily also lacks the features and limitations recited in these claims.

Claims 66 and 77 require that the request to send an electronic greeting card and to make an associated monetary gift in an amount be received from an electronic greeting card service. Previously, the Examiner argued that Van Dusen did not teach such. The Examiner now contends that Van Dusen teaches the requirements of claims 66 and 77, pointing to Figure 2 and column 3, lines 37-63. It is once again respectfully submitted that nowhere in Van Dusen, or any other applied reference, is it taught that such a request be received from an electronic greeting card service.

As best understood, the Examiner is now equating the gift certificate issuing entity (i.e., amazon.com) with an electronic greeting card service. However, even if the issuing entity were an electronic greeting card service, which it is respectfully submitted is not the case, the Examiner's arguments are not cogent. The Examiner, as best understood, argues that the act of transmitting the gift certificate to the recipient by the issuing entity somehow teaches the requirement that the **request** to send an electronic greeting card and to make an associated monetary gift in an amount be received from an electronic greeting card service. The Examiner's arguments in support of the rejection of claims 66 and 77 are entirely unclear, as

how operations performed after a transmission could possibly disclose requirements relating to limitations that give rise to that transmission is simply not understood.

Claims 67 and 78 require, *inter alia*, that the request to send an electronic greeting card and to make an associated monetary gift in an amount be received by, that the received request be processed by, and that the generated electronic greeting card be transmitted by an electronic greeting card service, and that the crediting of the funds be directed by a payment service provider. Thus, claims 67 and 78 require two entities to fulfill the request: an electronic greeting card service and an electronic payment service.

As above, Van Dusen lacks an electronic greeting card, a monetary gift, and a deposit account. Thus, it necessarily also lacks the features and limitations recited in these claims. The Examiner's rationale for the rejection is not understood. It seems that the Examiner is arguing that the issuing entity (i.e., amazon.com) is both an electronic greeting card service and an electronic payment service. If this were so, which is in no way admitted, it would be entirely contrary to the requirements of claims 67 and 78 that one entity receive the request, process the request, and transmit a generated electronic greeting card, while a different entity direct the crediting of funds to a deposit account.

Claims 68 and 79 require, *inter alia*, that the generated electronic greeting card, including the notification of the monetary gift, be transmitted, via the network, to an electronic greeting card service. In claim 68, this transmission occurs prior to transmitting the electronic greeting card, including the notification of the monetary gift, to the designated recipient.

The Examiner points to column 3, lines 37-63, of Van Dusen for such disclosure. First, as above, since Van Dusen lacks an electronic greeting card and a monetary gift, it necessarily also lacks the features and limitations recited in these

claims. Further, the Examiner argues, in response to prior traversal arguments, that the act of a donor transmitting a request to the issuing entity (which the Examiner construes as an electronic greeting card service) satisfies the claimed limitations. It appears the Examiner has completely ignored certain claim limitations in making his arguments regarding claims 68 and 79, namely that a **generated** electronic greeting card (again, not taught or suggested by Van Dusen) be transmitted to an electronic greeting card service. The e-mail message of Van Dusen is not generated until **after** the donor request is received, thus how the transmitted request could satisfy these claims is simply not understood.

Obviousness rejection of claims 58, 65, 67-69, and 75, 76, 79, and 80 over the Van Dusen/Lenhart combination

As discussed above, independent claim 58, from which claims 65, 67, and 68 depend requires, *inter alia*, that (1) a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, be received via a network; (2) the received request be processed to generate the electronic greeting card including a notification of the monetary gift; (3) the generated electronic greeting card be transmitted, via the network, to the designated recipient, and (4) a credit of funds equal to the amount of the monetary gift to a deposit account be directed.

Independent claim 69, from which claims 75, 76, and 79 depend, requires, *inter alia*, (1) a communications port configured to receive a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, via a network, and (2) a processor configured to process the received request to generate the electronic

greeting card including a notification of the monetary gift, and to direct a crediting of a deposit account in the amount of the monetary gift.

Independent claim 80 requires, *inter alia*, stored computer programming configured to be readable from a computer readable medium by a computer to thereby cause the computer to operate so as to (1) receive a request to make a monetary gift on behalf of a requesting donor to a designated recipient, and send an associated electronic greeting card, (2) generate the electronic greeting card including a notification of the monetary gift, based on the received request, (3) cause the electronic greeting card to be transmitted to the designated recipient, and (4) cause funds equal to the monetary gift amount to be credited to a deposit account.

As discussed above, Van Dusen does not teach or suggest an electronic greeting card, a monetary gift, or a deposit account. The Lenhart reference discloses, generally, electronic greeting cards (as discussed in prior responses). Lenhart in no way teaches or suggests a monetary gift or a crediting of a deposit account, as required by the independent claims. Thus, even if motivation to combine Van Dusen and Lenhart existed, which, as should be understood from prior traversal arguments and the discussion below, it does not, such a combination would not make these claims obvious, as well as not make their dependencies, claims 59-68, 81, and 70-79, obvious.

It is once again worthwhile to point out that simplicity and hindsight are not proper criteria for resolving obviousness. The fact that the prior art could be modified so as to result in the combination defined by the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. Obviousness cannot be properly established by simply showing that each claimed element may be found somewhere in the prior art. Furthermore, the fact that the prior art could be modified so as to result in the combination defined by

the claims would not have made the modification obvious unless the prior art suggests the desirability of the modification. Without a suggestion of the invention in the prior art reference combination, there is no motivation to combine the references. If there is no suggestion or motivation to combine the references in the prior art itself, there is no basis for the combination. Reliance on common knowledge and/or common sense cannot be the basis of finding obviousness. In the absence of a suggestion the basis for the rejection can only be viewed as nothing more than a hindsight reconstruction of the present invention using the Applicants' claims as a guide.

In response to prior traversal arguments regarding a lack of motivation, the Examiner asserts that by Van Dusen disclosing sending a gift certificate to commemorate a birthday, Van Dusen somehow "suggests modifying its teachings to include Lenhart's electronic greeting card" (paper no. 14, page 5, lines 5-7). It is respectfully submitted that this, as well as nothing else in Van Dusen, motivates such a combination, as Van Dusen never addresses electronic greeting cards, or anything corresponding thereto. Also, nothing in Lenhart suggests such a combination.

It is once again respectfully submitted that the only disclosure of record that makes a combination of Van Dusen and Lenhart obvious to the Examiner is the present application itself. This is an improper reconstruction which can only be based on the disclosure of the present application, since there is nothing explicitly or implicitly disclosed in the cited art which would lead one to the Examiner's asserted conclusions.

Furthermore, the Examiner has yet to provide an explanation of how one would modify Van Dusen in view of Lenhart to obtain the claimed invention, beyond the statement "a user might achieve transmitting an electronic greeting card by providing a more detailed optional message" (paper no. 14, page 6, lines 14-15).

How a more detailed message teaches a modification of Van Dusen to include features of Lenhart is simply not understood.

In summary, independent claims 58, 69, and 80 clearly distinguish over the applied prior art. Furthermore, other features recited in the dependent claims further distinguish over the applied prior art.

Claims 67 and 78, discussed above, are also rejected under the Van Dusen/Lenhart combination. The Examiner, however, provides no rational basis for this rejection. The extent of the examiner's arguments is "Lenhart overcomes this deficiency by teaching receiving a request to process an electronic greeting card as noted under claim 58 above." How receiving such a request teaches a first entity for receiving and processing a request, as well as transmitting an electronic greeting card, and a second entity for directing a crediting of funds can only be speculated. The Examiner has provided no reasonable rationale for the rejection.

Regarding claims 68 and 79, discussed above, the Examiner argues that a combination of Van Dusen and Lenhart would make such obvious. Similar to the Examiner's 35 U.S.C. §102 rejection of these claims, the 35 U.S.C. §103 rejection is simply not understood. The Examiner seems to argue that "a Website operative to transmit an electronic greeting card wherein a sender fills out a personalized message" somehow teaches transmitting a generated electronic greeting card to an electronic greeting card service provider. Again, the Examiner has provided no reasonable rationale for the rejection.

Obviousness rejection of claims 59-62, 64, and 70-73 over the Van Dusen/Albrecht combination and Obviousness rejection of claims 59-62, 64, and 70-73 over the Van Dusen/Lenhart combination in further view of Albrecht

Claims 59 and 70 require, *inter alia*, that the electronic greeting card notifying a designated recipient of a monetary gift be transmitted either (i) subsequent to the directing of the crediting of funds to the deposit account, or (ii) concurrent therewith.

The Examiner acknowledges that both individually and in combination Van Dusen and Lenhart fail to disclose these limitations. Accordingly, the Examiner proposes to further modify either Van Dusen or Van Dusen/Lenahrt based upon Albrecht's disclosure.

Albrecht (U.S. Patent No. 5,984,180) discloses a method and system for giving a gift credit card. The gift credit card (referred to as a secondary account) is linked to a donor's credit account (abstract). It should be noted that Albrecht is directed to credit accounts, not deposit accounts. Also, Albrecht does not disclose or suggest electronic greeting cards or electronic gift certificates. Rather, Albrecht discloses that an actual credit card is delivered (column 6, lines 9-10). According to the Albrecht technique, the secondary account is established prior to delivering the gift credit card to the recipient.

The Examiner argues that Albrecht teaches transmission of an electronic greeting card either subsequent to directing a crediting of funds to a deposit account, or concurrent with directing a crediting of funds to a deposit account. The Examiner's position is not understood. Albrecht does not disclose any transmission of an electronic greeting card, and does not disclose a deposit account. Accordingly, at least for this reason, the proposed combination, for which there is no motivation, does not make claims 59 and 70 obvious.

Claims 60 and 71 require, *inter alia*, that the generated electronic greeting card include a hyper-link, that the funds be directed to be credited subsequent to an activation of the hyper-link, and that the deposit account be at a financial institute.

The Examiner acknowledges that Van Dusen, Lenhart, or a combination or both, fails to teach a deposit account at a financial institute, and looks to Albrecht for such. Even if Albrecht discloses a financial institute, which is not admitted, Albrecht does not disclose a deposit account, as discussed above. Further, the Examiner has ignored the express limitation that the credit be directed subsequent to an activation of the hyper-link included in the generated electronic greeting card. The Examiner acknowledges, in the second full paragraph on page 16 of paper no. 14, that "Albrecht teaches a method and system for providing a gift card wherein a gift card balance is established by a donor prior to providing the gift card to the recipient." Thus, the Examiner's own analysis of Albrecht flies in the face of the assertion that Albrecht teaches the limitations of claims 60 and 71.

Claims 64 and 75 require, *inter alia*, debiting a payment account associated with the requesting donor subsequent to activation of a hyper-link included in the transmitted electronic greeting card, with claim 64 further requiring the payment account to be at a financial institute. The Examiner argues that Van Dusen teaches, at column 3, lines 55-63, the debiting of a payment account associated with the donor subsequent to activation of a hyper-link included in a transmitted electronic greeting card. The Examiner acknowledges that Van Dusen, Lenhart, or a Van Dusen/Lenhart combination, does not teach or suggest a financial institute, and looks to Albrecht for such.

Regarding the Examiner's reliance upon Van Dusen for the debiting subsequent to activation of a hyper-link included in a transmitted electronic greeting card, Van Dusen does not support the Examiner's position. Van Dusen in the

referenced text, and elsewhere, discloses that a donor always pays for a gift certificate prior to a gift certificate being created, let alone being transmitted.

Alternative Obviousness rejection of claims 66, 77, and 78 over the Van Dusen/Lenhart combination in further view of Official Notice

Claims 66, 77, and 78, each discussed above, recite an electronic greeting card service, with claims 66 and 77 reciting that the request is received from an electronic greeting card service, and with claim 78 reciting that the request is received by an electronic greeting card service.

The Examiner argues that "outsourcing a services (sic) is old and well known. Therefore, at the time of Applicants' invention, it would have been obvious to one of ordinary skill in the art, to modify Van Dusen and Lenhart to include receiving the request from an electronic greeting card service. This combination would allow the greeting card service to outsource the card transmitting function thereby allowing the greeting card service to lower its operating costs" (paper no. 14, section 23, bridging pages 21 and 22).

It seems as though the Examiner has again ignored expressly mandated claim limitations. The claims do not recite a mere 'outsourcing' of a transmission function. In particular, the Examiner never addresses the requirement of claim 78 that the request be received by an electronic greeting card service. Also, it is respectfully requested that the Examiner cite, and properly apply, prior art in support of the Official Notice that it is old and well known to receive, **from** an electronic greeting card service, a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, as required by claims 66 and 77. It is also respectfully

requested that the Examiner cite, and properly apply, prior art in support of the Official Notice that it is old and well known to receive, **by** an electronic greeting card service, a request to send an electronic greeting card and to make an associated monetary gift in an amount, on behalf of a requesting donor to a designated recipient, as required by claim 78.

Obviousness rejection of claim 81 over the Van Dusen/Lenhart combination in further view of Official Notice

The Examiner acknowledges that neither Van Dusen, Lenhart, or a combination of the two, disclose directing a debiting of funds equal to the monetary gift amount from a deposit account at a financial institution associated with the requesting donor to a deposit account at a financial institution associated with the service provider.

The Examiner does argue, though, that "Van Dusen suggests implementing this combination in that Lenhart discloses receiving credit card payments." However, the Examiner does not indicate where in Van Dusen such is suggested. As should be understood from the discussion above, neither Van Dusen nor Lenhart disclose the required debiting of claim 81.

Furthermore, the Examiner has once again ignored express claim limitations. In particular, the Examiner has ignored the requirement that the funds directed to be credited are from the service provider's deposit account.

In any event, it is respectfully requested that the Examiner cite, and properly apply, prior art in support of his Official Notice.

In view of the above, it is respectfully requested that the Examiner reconsider and withdraw the prior art rejections.

It is respectfully submitted that the application is in condition for allowance and an early indication of the same is courteously solicited. The Examiner is respectfully requested to contact the undersigned by telephone at the below listed local telephone number, in order to expedite resolution of any remaining issues and further to expedite passage of the application to issue, if any further comments, questions or suggestions arise in connection with the application.

Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 01-2135 and please credit any excess fees to such deposit account.

Respectfully Submitted,

ANTONELLI, TERRY, STOUT & KRAUS, LLP



Sterling W. Chandler
Registration No. 51,370

SWC
Suite 1800
1300 North Seventeenth Street
Arlington, VA 22209
Telephone: (703) 236-6081
Facsimile: (702) 312-6666
E-mail: schandler@antonelli.com
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